

SEP 26 2006

sectionally circular tubular portion tapers radially outwardly in a rearward direction away from the outlet.

### REMARKS/ARGUMENTS

Claims 18, 19 and 21-31 are pending in the application.

In the Final Office Action:

1. Claims 18, 19, 21, 22, 30 and 31 are rejected under 35 USC 102(e) as being anticipated by U.S. 6,726,699 issued to Wright et al. ("Wright");
2. Claims 23 and 24 are rejected under 35 USC 103(a) as being unpatentable over Wright in view of U.S. 6,224,608 issued to Ciccolella et al. ("Ciccolella"); and
3. Claims 23 and 25-29 are rejected under 35 USC 103(a) as being unpatentable over Wright in view of U.S. 4,655,752 issued to Honkanen et al. ("Honkanen").

Claim 18 claims a tool guide having an elongated body and "an engaging formation defined within the passage of the body" and "arranged to hold and provide a stop for a complementary engaging formation on a robotic arm". An example of such a tool guide 410 is shown in FIGS. 11-13 of the application, wherein an engaging formation 416 (shaped as a socket formation) is defined within a passage 414 of an elongated body 412 of the tool guide 410, and is arranged to hold and provide a stop for a complementary engaging formation 442 of a robotic arm. An example of such a complementary engaging formation 442 is shown as a guide 60 of a robotic arm 26 in FIGS. 9-10 of the application, as explained in paragraph [0089] of the published application 2004/0054355 A1.

The Final Office Action asserts that two structures in FIG. 1 of Wright respectively teach the engaging formation of an instrument guide 24 and the complementary engaging formation of a robotic arm 16 as claimed in claim 18. As

pointed out in the Amendment after Final filed June 19, 2006 (the "Amendment after Final"), however, there is insufficient description in Wright to affirmatively determine whether such identifications are correct, and further, based upon a careful reading of Wright, such identifications appear to be more likely incorrect, as elaborated therein and below.

As a preliminary matter, although the Advisory Action is arguably correct in its assertion that the complementary engaging formation on the robotic arm is not positively claimed, its proper identification is very useful, however, in order to determine whether or not "an engaging formation defined within the passage of the body", such as that claimed in claim 18, is either taught or suggested by Wright.

The Final Office Action asserts that Figure 1 in Wright teaches the complementary engaging formation of the robotic arm 16. Applicants respectfully disagree. Figure 1 in Wright illustrates a spring-loaded or threaded mechanism to facilitate removably coupling the instrument guide 24 to the tool driver 20. Applicants consulted with Mr. Paul Milman, a former Computer Motion Inc. engineer who is familiar with the design taught by Wright. Computer Motion Inc., the assignee of Wright, and all its product lines were acquired by Intuitive Surgical, the assignee of the present invention in August 2003. Mr. Milman indicated that instrument guide 24 has a protruded formation which protruded formation when inserts into a receptive formation on the tool driver 20 can be locked in place either by a twisting action or by engaging a spring-loaded pin.

Thus, it is the abutting outer surfaces of the tool driver 20 and the stop of the instrument guide 24 that make a physical engagement, and clearly such stopping

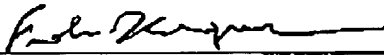
engagement does not occur within a passage of the tool guide 24 as claimed in the present invention. Wright is therefore clearly distinguished from claim 18 of the present invention since it does not satisfy the requirements of the engaging formation as recited in claim 18 (i.e., being defined within the passage of the body of the tool guide). Accordingly, claim 18 is believed to be patentable under 35 USC 102(e).

Claims 19 and 21-31 are also believed to be patentable under 35 USC 103(a) since they depend from claim 18, and as such, are believed to be patentable for at least the same reasons as stated in reference to claim 18. In particular, neither Ciccolella nor Honkanen teaches or suggests a tool guide having an engaging formation that is defined within a passage of the body of the tool guide, and in order to be a proper rejection under 35 USC 103(a), at least one of the cited references must teach or suggest this element of the claims.

Claims 18, 19 and 21-31 are pending in the application. Claim 20 has been cancelled. Reconsideration of the rejections of the claims is respectfully requested for the reasons stated herein, as well as any other applicable reasons stated in prior communications, and an early notice of their allowability earnestly solicited. If the Examiner believes that it may expedite the prosecution of this application to discuss this case with applicants' attorney, she is encouraged to contact applicants' attorney at the number indicated below.

Respectfully submitted,

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